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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,374	02/23/2005	Kei Etou	7398/84282	5196
42798	7590	05/09/2008		
FITCH, EVEN, TABIN & FLANNERY P. O. BOX 18415 WASHINGTON, DC 20036			EXAMINER BURNEY, RACHEL L	
			ART UNIT	PAPER NUMBER
			1795	
			MAIL DATE	DELIVERY MODE
			05/09/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/525,374	<b>Applicant(s)</b> ETOU ET AL.	
	<b>Examiner</b> Rachel L. Burney	<b>Art Unit</b> 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 10-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/19/2007, 12/03/2007</u> .                                  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statements (IDS) submitted on 10/19/2007 and 12/03/2007 were filed after the mailing date of the application on 02/23/2005. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Claim Objections***

2. Claim 6 is objected to because of the following informalities: the claim as amended recited "according to claim 1 one of claims 1 to 6". The examiner has interpreted this to mean "according to claim 1". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. Claims 1-4, 6-7, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5350657, Anno et al.

With respect to claims 1-4, Anno discloses a toner comprising a resin having a softening point of 80-150°C (column 3, lines 34-38), wherein the toner has a core and a film-formed on the surface of the core (column 6, lines 22-28), wherein the coating resin is a thermosetting resin, such as urea (column 11, lines 31-40) and the toner may be produced by grinding (column 10, lines 46-51). Because the toner of Anno is substantially similar to that of the instant application, and has similar properties, such as the softening point, it would be reasonable to conclude that the covered toner of Anno would have substantially similar properties, including a fusing temperature of 145°C or lower.

With respect to claim 6, Anno discloses the toner of claim 1 as discussed above, wherein the film is put on the core in a specific surface area (column 2, lines 8-13), which is useful for coating the toner. Anno does not disclose the thickness of the film, however it would be reasonable to conclude that the thickness falls within the desired range of the instant application because Anno discloses the same film-forming resin used in a similar fashion.

With respect to claim 7, Anno discloses the toner of claim 1 as discussed above, wherein the toner is a polymerized (column 16, lines 13-19).

With respect to claim 9, Anno discloses the toner of claim 1 as discussed above, wherein it is desired to make spherical toner particles (column 16, lines 17-19). Anno does not disclose the true sphericity as defined in the instant application,

but it would be reasonable to conclude that the true sphericity would overlap with the desired ranges because both the instant application and Anno are attempting to make spherical toner particles.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5350657, Anno et al. as applied to claim 3 above, and further in view of US

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Patent 5294513, Mitchell et al. Anno discloses the use of thermosetting urea resins, but fails to teach urea-formaldehyde resins. Mitchell discloses an encapsulated toner material wherein the shell contains a urea-formaldehyde thermosetting resin (column 2, lines 17-32). It would have been obvious to one of ordinary skill in the art at the time of the invention to use the urea-formaldehyde thermosetting resin of Mitchell as the urea thermosetting resin of Anno because Mitchell teaches the use of the resin in a similar embodiment, and one would have a reasonable expectation of success in doing so.

8. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5350657, Anno et al. as applied to claim 7 above, and further in view of US PGPub 2002/0055050, Serizawa et al. Anno discloses a method of making the toner which involves a polymerization reaction while agitating, but fails to teach aggregation. Serizawa discloses a toner which is formed by aggregation, which includes polymerization and agitating the toner particles. It would have been obvious to one of ordinary skill in the art at the time of the invention to use aggregating by polymerization and agitating, as taught by Serizawa, in the polymerizing and agitating step of Anno, and one would have a reasonable expectation of success in doing so.

## ***Response to Arguments***

### *Claim Objections*

9. In view of the amendments to the claims, filed on 02/06/2008, the objections to claims 6-9 have been withdrawn, however claim 6 has been objected for alternative reasons, as discussed above.

### *Claim Rejections - 35 USC § 102*

10. Applicant's arguments, see pages 5-8, filed 02/06/2008, with respect to the rejection(s) of claim(s) 1-5 under US Patent 5294513, Mitchell et al. have been fully considered and are persuasive in view of the amendments to the claims. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made as discussed above.

## ***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Burney whose telephone number is (571)272-9802. The examiner can normally be reached on Mon-Thurs: 7:30-6:00 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RLB

**/Mark F. Huff/  
Supervisory Patent Examiner, Art Unit 1795**